

DOCKET NO: 242320US6

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
YOSHIKAZU KATO : EXAMINER: COPPOLA, J
SERIAL NO: 10/656,274 :
FILED: SEPTEMBER 8, 2003 : GROUP ART UNIT: 3621
FOR: INFORMATION PROCESSING :
APPARATUS, INFORMATION
PROCESSING METHOD, STORAGE
MEDIUM, AND PROGRAM

PETITION UNDER 37 C.F.R. § 1.181

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This Petition is in response to the Official Communication mailed on August 4, 2009.

This Petition under 37 C.F.R. § 1.181 requests that the objection to the specification under 37 C.F.R. §1.75(d)(1) on page 2 of the outstanding Action be withdrawn as improper.

The outstanding Action objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the outstanding Action objected to the “means” elements recited in Claim 1 stating that the terms “means for receiving”, “means for storing”, “means for managing”, “means for reading”, “means for arranging” and “means for composing” do not have proper “antecedent basis” in the disclosure.

MPEP §608.01(o) states “the meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import.”

37 C.F.R. §1.75(d)(1) states:

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

As is noted in *Plastic Container Corporation, V. Continental Plastics Of Oklahoma, Inc*, 203 U.S.P.Q. 27; 607 F.2d 885, “because Rule 75(d)(1) merely implements the description requirement of the first paragraph of 35 U.S.C. § 112...we consider § 112 to be the statutory basis for this conclusion of law.” Thus, as 37 C.F.R. §1.75(d)(1) is merely an extension of 35 U.S.C. §112, first paragraph, MPEP §1302.01 (which mentions MPEP §608.01(o)) also applies to 37 C.F.R. §1.75(d)(1).

MPEP §1302.01 provides that

There should be clear support or antecedent basis in the specification for the terminology used in the claims. Usually, the original claims follow the nomenclature of the specification; but sometimes in amending the claims or in adding new claims, applicant employs terms that do not appear in the specification. This may result in uncertainty as to the interpretation to be given such terms. See MPEP § 608.01(o). **It should be noted, however, that exact terms need not be used in haec verba** to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112. *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). See also 37 CFR 1.121(e) which merely requires substantial correspondence between the language of the claims and the language of the specification. (emphasis added).

Further MPEP 2173.05(e) states

A CLAIM TERM WHICH HAS NO ANTECEDENT BASIS IN THE DISCLOSURE IS NOT NECESSARILY INDEFINITE

The mere fact that a term or phrase used in the claim has no antecedent basis in the specification disclosure does not mean, necessarily, that the term or phrase is indefinite. **There is no requirement that the words in the claim must match those used in the specification disclosure.** Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the

invention with a reasonable degree of clarity and precision.
(emphasis added).

Thus, Applicants note that “find[ing] clear support or antecedent basis in the description” does not require that the exact terms recited in the claims be included in the disclosure portion of the specification.

The outstanding Action appears to be taking the position that requiring “antecedent basis” for a term in the specification corresponds to requiring that the “exact terms” of the claim be found in the specification, this position is improper. As is noted above, the term “antecedent basis” found in 37 C.F.R. §1.75(d)(1) is equivalent to “clear support.”

In the present case, support for the terms “means for receiving”, “means for storing”, “means for managing”, “means for reading”, “means for arranging” and “means for composing” is clearly found in the disclosure. Evidence of this point is that no §112, first paragraph rejection was issued in the outstanding Action.

Moreover, Applicants note that the term “means for” is a term of art and is used to invoke §112, sixth paragraph for a claim. For example, Claim 1 recites “storing means for storing a plurality of content data corresponding to the at least one order.” Page 3, line 17 of the disclosure portion of the specification describes “a storing element” for storing content data. Clearly the term “storing” has antecedent basis in the disclosure. The term “means for” is intending to invoke §112, sixth paragraph and is not a part of the element.

Accordingly, it is respectfully submitted that this Petition under 37 C.F.R. §1.181 be granted and that the Examiner withdraw objection to the specification under 37 C.F.R. §1.75(d)(1).

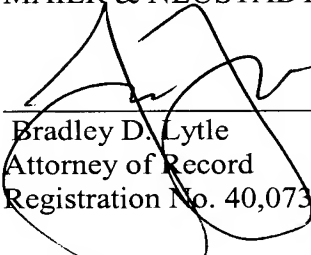
Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

James Love
Registration No. 58,421